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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,709	10/23/2001	Yuji Saiki	04558.057001	2960
38834	7590	07/13/2004	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP			SEFER, AHMED N	
1250 CONNECTICUT AVENUE, NW			ART UNIT	
SUITE 700			PAPER NUMBER	
WASHINGTON, DC 20036			2826	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,709

Applicant(s)

SAIKI ET AL. 

Examiner

A. Sefer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed April 30, 2004 has been entered and new claims 28-33 have been added.

Response to Arguments

2. Applicant's arguments filed 4/30/2004 have been fully considered but they are not persuasive.
3. Applicants argue that Yoshimi et al. ("Yoshimi") (JP 6-59123) does not teach or suggest a structure in which two polarizers are laminated on one side of a liquid crystal cell.
4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., two polarizers are laminated on one side of a liquid crystal cell) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Specification

5. The disclosure is objected to because of the following informalities: The limitation "at least one other optical layer" is confusing -- no optical layer has been recited in previous claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation "an adhesive layer provided on an exposed surface of the optical member for adhesion with other members" recited in claim 30 is not disclosed in the specification to enable one skilled in the art to make and/or use the invention -- on page 13, lines 11-14 of the specification, it is described that an adhesive layer is exposed on the surface. Without this information it would take undue experimentation to make and use the claimed invention.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 30 recites the limitation "the optical member". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 1-7, 11, 13-15, 17-20, 22, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimi (of record).

Yoshimi discloses (see figs. 1-7 and computer translated document) a liquid crystal display comprising on at least one side of a liquid crystal cell or a polarizing plate 4 comprising a polarizer, the polarizer comprising: a first portion having a polarization degree of 99% at wavelength of light for wavelengths within the range recited in the claim and a second portion having a polarization degree of 99% or more at wavelength of light for wavelengths within the range recited in the claim wherein the first portion and the second portion are laminated by an adhesive 5 (as in claims 2 and 14) or pressure-sensitive adhesive (as in claims 6 and 15) or directly laminated (as in claim 17) by an adhesive (as in claim 18).

Although Yoshimi does not specifically disclose a polarization degree at each wavelength, it is standard to take measurements at intervals such as every 10nm as disclosed by Yoshima, since that would provide a more accurate result.

As for claims 4 and 5, Yoshimi discloses (see computer translated document) the adhesive is a polyvinyl alcohol-based adhesive or urethane-based adhesive (as in claim 5).

As for claim 11, Yoshimi discloses a viewing angle compensating film 1 attached to the polarizing plate.

Regarding claims 3 and 7, the specification contains no disclosure of either the critical nature of the claimed arrangement or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

As for claims 22, 24 and 26, Yoshimi discloses a polarizing plate located on one side of a liquid crystal cell 6.

12. Claims 8-10, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimi in view Ozeki et al. ("Ozeki") USPN 6,498,633 (of record).

Yoshimi et al disclose the device structure as recited in the claim, but do not specifically disclose an absorption axis.

Ozeki discloses (see col. 4, lines 52-58) a polarizing plate comprising a polarizer, the polarizer comprising two portions of a polarizer laminated so that the absorption axis are disposed in parallel to each other.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to incorporate of Ozeki's teachings with Yoshimi's device since that would provide a desired wavelength dependence as taught by Ozeki.

As for claims 9 and 10, Ozeki discloses (see col. 7, lines 54-57) a reflector/ transreflector or a retardation plate 4 (as in claim 10) attached to the polarizing plate.

As for claims 28 and 29, Ozeki discloses (see col. Col. 7, lines 58-62 and col. 8, lines 1-8) at least one other optical layer 4 or at least two other optical layers.

13. Claims 12, 16 and 21, 23, 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimi in view Kameyama et al. ("Kameyama") USPN 6,088,079 (of record).

Yoshimi discloses the device structure as recited in the claim, but do not specifically disclose a brightness enhancement film attached to polarizing plate.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to incorporate Kameyama's teachings with Yoshimi's device since that would improve display brightness as taught by Kameyama.

Regarding claim 16, Kameyama discloses (see col. 15, lines 1-25) a separator. As for its function, a recitation of an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As for claims 21, 23, 25 and 27 Kameyama discloses (see col. 11, lines 6-13) a polarizing plate transmitting a linearly polarized light having a predetermined polarization axis.

14. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimi in view of Koike et al. ("Koike") USPN 6,654,085.

Yoshimi discloses the device structure as recited in the claim, but does not specifically disclose an adhesive layer provided on an exposed surface of the optical member.

Koike discloses in figs. 2-4 a polarizing plate comprising a polarizer 51 and adhesive layer 4/52 on an exposed surface of surface of an optical member 3/6.

As for claim 31, an adhesive temporarily being covered would exist in the final production therefore, reads to a process and "product by process" claims are directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685 and *In re Thorpe*, 227 USPQ 964, 966. Therefore, the way the product was made does not carry any patentable weight as long as the claims are directed to a

device. Further, note that the applicant has the burden of proof in such cases, as the above case law makes clear. Also see MPEP 2113.

15. Claims 32 and 33, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimi in view of Ochi et al. ("Ochi") USPN 6,094,245.

Yoshimi discloses the device structure as recited in the claim, but does not specifically disclose a transparent protective film.

Ochi discloses (see fig. 2 and the paragraph bridging cols. 6 and 7) a polarizing plate comprising a polarizer 31 and a transparent protective film.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to incorporate Ochi's teachings with Yoshimi's device since that would prolong the life service of the polarizer as taught by Ochi.

As for claim 33, Ochi discloses no protective layer between first and second portions of the polarizer.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Sefer whose telephone number is (571) 272-1921.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ANS
July 5, 2004


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